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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,434

01/26/2004

Donald E. Black

4012

3611

29356

7590

09/06/2006

JERRY SEMER  
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FREMONT, OH 43420

EXAMINER

CHAMBERS, MICHAEL S

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/766,434

Applicant(s)

BLACK, DONALD E.

Examiner

Mike Chambers

Art Unit

3711

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,7-11,13 and 16-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1,3,7-11,13 and 16-20 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,7,9,11,17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (2379006) in view of Pomilia (4682773). Johnson discloses the elements of claim 1, however it fails to disclose a bat with a smaller diameter than a conventional bat. Pomilia discloses a bat with a smaller diameter than a conventional bat (fig 1, 1:30-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the shape of the Pomilia device with the bat of Johnson in order to increase user satisfaction by permitting the user to improve their eye and hand coordination (1:34-35).

As to claim 7: Johnson discloses a threaded portion (fig 3).

As to claim 9: Johnson discloses a plastic material (fig 3, 2R:9-11).

As to claim 11: Johnson discloses an outer cap (fig 1).

As to claim 17: Johnson discloses a threaded portion (fig 3).

As to claim 19: Johnson discloses a plastic material (fig 3, 2R:9-11).

Claim 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (2379006) in view of Pomilia (4682773) as applied above and further in view of Franssen (6918843). Franssen discloses a bore of a consistent diameter (fig 2). The

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specification provides no surprising or unexpected results from using a bore of a consistent diameter therefore this is considered a design choice. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the consistent bore of Franssen with the apparatus in order to reduce the number of manufacturing steps and reduce the cost to manufacture the item and increase user satisfaction.

Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (2379006) in view of Pomilia (4682773) as applied above and further in view of Owen et al (3116926). Owen discloses the use of a compression spring (fig 2). The specification provides no surprising or unexpected results from the position of the spring, therefore this is considered a design choice. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the spring retention means of Owen with the apparatus in order to more easily change weight locations and sizes and increase user satisfaction.

Claims 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (2379006) in view of Pomilia (4682773) as applied above and further in view of Official Notice . Official Notice was taken in the prior office action that the use of aluminum is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to select any one of several equivalent materials including aluminum and plastic based on cost and design considerations.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (2379006) in view of Pomilia (4682773) as applied above and further in view of Owen

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et al (3116926). Owen discloses the use of a flanged end cap (fig 6). The specification provides no surprising or unexpected results from the use of a flanged end, therefore this is considered a design choice. It would have been obvious to one of ordinary skill in the art at the time of the invention to select any one of several equivalent end caps based on cost and design considerations.

### ***Response to Arguments***

Applicant's arguments with respect to the existing claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4682773\*2379006\*3116926\*6918843

Michael Chambers  
Examiner  
Art Unit 3711

August 31, 2006

  
EUGENE KIM  
SUPERVISORY PATENT EXAMINER